

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Initial Patent Application of:

COMISKEY et al
Serial No. 08/230,895
TRADEMARKS

Filed: May 11, 1994

Atty Dkt: 1723-4
C# M#

Group Art Unit: 1513

Examiner: Macholl

REFLECTED LIGHT GLARE MINIMIZATION FOR
ATHLETIC CONTEST ...

Honorable Commissioner of Patents
and Trademarks
Washington, DC 20231

Date: February 17, 1995

Sir:

95-3656

[] NOTICE OF APPEAL:

Applicant hereby appeals to the Board of Appeals from the decision dated
of the Examiner twice/finally

rejecting claims	(\$280)	\$
[X] An appeal BRIEF is attached in triplicate in the pending appeal of the above-identified application (\$280)	\$ 280.00	0
[X] Amendment Under MPEP 1207	\$	0
[] An <u>ORAL HEARING</u> is requested under Rule 194 (\$240)	\$	
(due within two months after Examiner's Answer)		
[] Credit for fees paid in prior appeal without decision on merits	-\$()	
[] A reply brief is attached in triplicate under Rule 193(b)		(no fee)
[] Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)	\$	
(\$110/1 month; \$370/2 months; \$870/3 months; \$1,360/4 months)		
[X] Applicant is a "small entity"; enter 1/2 of subtotal and subtract	SUBTOTAL	\$ 280.00
[] "small entity" statement attached	-\$()	140.00)
	SUBTOTAL	\$ 140.00
Less month extension previously paid on	-\$()	
	TOTAL FEE ENCLOSED	\$ 140.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which
should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No.**
14-1140. A duplicate copy of this sheet is attached.

1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
RAV/eaw

NIXON & VANDERHYE P.C.

By Atty.: Robert A. Vanderhye

Reg. No. 27076

Signature: 

#12
3-13-95
RECEIVED
MAR 08 1995
GROUP 1500

140-220

GP 1513
10P3



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

COMISKEY et al

Atty. Ref.: 1723-4

Serial No.: 08/240,895

Group: 1513

Filed: May 11, 1994

Examiner: Macholl

For: **Reflected Light Glare
Minimization for Athletic
Contest Participants While
Providing a Non-Verbal
Communication**

* * * * *

February 17, 1995

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

**THIS CASE HAS BEEN GRANTED SPECIAL
STATUS.**

95-3656

APPELLANTS' BRIEF

Sir:

Applicants hereby appeal the Final Rejection of October 18, 1994.

I. **STATUS OF CLAIMS**

Claims 1, 2, 6 through 13 and 16 through 19 have been rejected. Claims 3 through 5, 14, 15 and 20 have been withdrawn from consideration. No claims have been allowed.



II. STATUS OF AMENDMENTS

No amendment has been filed after the date of the Final Rejection, however by a letter dated December 19, 1994 a declaration was submitted that removed the formality objection on page 2, paragraph 2 of the Final Rejection. See the Advisory Action, paper no. 9, dated December 30, 1994. Also filed herewith is an amendment under MPEP 1207 to correct a readily apparent error in claim 9.

III. SUMMARY OF THE INVENTION

The invention relates to a method of reducing reflected light glare into the eyes 14, 15 of a human (see figure 1) while simultaneously providing a non-verbal communication by the human to others, and to a decal 38, 39 (see figure 3) or temporary tattoos 48, 49 (see figure 4), or 59, 61 (see figures 5 through 7) which are used to practice the method.

In the method a non-toxic material having a non-reflective colored and finished exterior in the form of a predefined clearly demarcated geometric shape which provides a non-verbal communication to others, such as the decals 38, 39, temporary tattoos 48, 50, or eye black 25 applied with the eye black marker 24 (see figure 2), are applied underneath the human's eyes on the human's cheeks 12, 13, as indicated by the shapes 10, 11 in figure 1. The non-toxic, non-reflective material covers a reflective location on the cheeks at which incident direct or indirect light is likely to be reflected into the human's eyes. Within a week after application the material is removed. Typically, the material is removed

immediately after an athletic contest, the non-reflective material being primarily used in the same manner that conventional eye black is used by outdoor athletes.

It is well known in the promotion of sports apparel and equipment by apparel or equipment manufacturers or distributors that one of the highest visibility manners in which their products can be advertised are by having participants in highly visible athletic contest (particularly those that are televised) advertise their products. The method of the invention provides a highly visible and suitable way to do that, for example by providing the non-verbal communication provided by the non-reflective material on the wearer's cheeks as the logo, trademark, or trade name of a sports apparel or equipment manufacturer or distributor. For example see the designation "LOW" at 53 in figure 4, and the geometric shapes of the decals 38, 39 and temporary tattoos 48, 49, which are illustrated as the logos of a mythical sports apparel manufacturer or distributor. The method may also be practiced so that the clearly demarcated geometric and predefined shapes are the representation of a sports team's name, mascot, or logo, such as illustrated in figures 6 and 7.

When the material provided is a temporary tattoo, it is provided on a substrate 50 and illustrates the reverse of the clearly demarcated geometric and predefined shape, as seen in figure 4. The temporary tattoo is applied to the human's face, so that it is as illustrated in figure 1, by cleaning the cheek, applying the temporary tattoo to the cleaned cheek, wetting the bottom face of the

substrate 50 with water, and pressing it into contact with the cheek a sufficient time for the temporary tattoo to adhere to the cheek, and then sliding off the substrate 50 from the temporary tattoo. Ultimately the temporary tattoo can be rubbed off using alcohol or baby oil, or by applying tape to it and pulling off the tape.

The geometric shape is preferably within a primarily black or dark colored area (e.g. sized to comply with regulations of a regulatory body), with the letters or logo, or any demarcation between the letters and the primarily black or dark colored area, appearing as a dull or matte color and having a wavelength of greater than about 690 nm and less than about 430 nm, and absorbing most of the light in the visible spectrum. As seen in all of figures 1 through 4 the logo may have a directional bias, and the logo is applied with the correct directional bias under one of the human's eyes and with a reverse of the correct directional bias under the other (see figure 1). The decal or temporary tattoo has a size and non-reflectivity to substantially eliminate the reflection of incident direct or indirect light off the human's cheeks into the human's eyes.

IV. ISSUES ON APPEAL

Are claims 1, 2, 6 through 13 and 16 through 19 indefinite for failure to particularly point out and distinctly claim the subject matter which applicant regards as the invention as required by 35 USC §112, second paragraph?

Are claims 1, 2 and 8 through 12 obvious, pursuant to 35 USC §103, over the conventional use of eye black for athletes?

Are claims 1, 2, 6 through 13 and 16 through 19 obvious, pursuant to 35 USC §103, over conventional temporary tattoos as exemplified by the Team Dynamics, J.B. Marketing, Inc., and Anderson's brochures?

V. GROUPING OF CLAIMS

All the claims are independently patentably distinct from each other for the reasons set forth in detail in the Argument section below, except that on this particular record the 35 USC §112 rejections of claims 6 through 8 and 11 stand or fall with the 35 USC §112 rejection of claim 2, and the 35 USC §112 rejections of 12, 13 and 16 stand or fall with the 35 USC §112 rejection of claim 1, and the 35 USC §112 rejection of claims 18 and 19 stand or fall with the 35 USC §112 rejection of claim 17; and the obviousness rejection of claim 7 stands or falls with the obviousness rejection of claim 6.

VI. ARGUMENT

The Sports Illustrated cover submitted by applicant is exemplary of the prior art over which the invention is an improvement. Conventional eye black is illustrated, used for the purpose of minimizing the reflectivity of light off of the football player's cheeks into his eyes. The eye black has an amorphous shape which has no meaning to anyone viewing the athlete. In sharp contra-distinction to the prior art the invention provides not only essentially the same functionality

as the conventional eye black illustrated in the Sports Illustrated article, but also provides a non-verbal communication to others -- that is the eye black has a predefined clearly demarcated geometric shape which means something.

Perhaps the best commercial use of the invention is in the advertisement of athletic apparel or equipment. Sports apparel and equipment manufacturers spend hundreds of millions of dollars worldwide in endorsement contracts in which athletes wear their products. They sponsor sporting events to ensure that their name is always before the public, and display their logos on billboards in stadiums where games are played and on television message indicators which indicate the score, time remaining, or the like. In view of the expenditure of these hundreds of millions of dollars it is inconceivable that the marketing opportunity provided according to the present invention could have been missed if it were obvious! Imagine the player introductions at the Super Bowl where the camera focuses in on the players' faces and where the most valuable player in the league quarterback is introduced with a sports apparel logo in "eye black" under his eyes; or the sideline TV segments during the Pro Bowl game in Hawaii where Lynn Swann or Ahmad Rashad is interviewing an athlete after a spectacular play and his "eye black" shows a sports equipment manufacturer's name.

All of the Claims are Definite Pursuant to 35 USC §112

In the Final Rejection rather than explaining why something is vague or indefinite questions are merely asked. It is not the purpose of the claims to be

technical specifications which answer all questions; In re Johnson, 194 USPQ 187, 195 (CCPA 1977). The purpose of the claims is to set forth, in view of the specification, what someone will be infringing -- that is what the invention protects. A rejection on indefiniteness cannot be used as a mechanism for limiting the scope of the claims since the claims may be as broad as allowed by the prior art without being considered indefinite or incomplete. MPEP 706.03(d), second paragraph.

With respect to claim 1, and the "direct or indirect" light limitation, that merely refers to all light, and whether there would be any difference in the construction if only direct light was being dealt with is irrelevant. The purpose of the claims is for someone to know whether or not they would be infringing, and one of ordinary skill in this art -- to whom the application claims are directed -- would clearly and unequivocally known that viewing the present claims. By calling for both types of light, direct or indirect, applicants are making it clear that the reflection of both types of light into the human's eyes is being dealt with, which may or may not be clear if simply the word "light" was used.

With respect to "substantially eliminate reflection" apparently what the Final Rejection seeks is either a recitation that all reflection be eliminated otherwise one is not infringing, or that a percentage be set forth. The law does not require such specificity where there is no art to require it. Nor is there anything unusual -- as suggested on page 4 of the Final Rejection -- about the use

of the term "substantially" in the claims here compared to other contexts. For example there was no more indefiniteness in using the word "substantially" to define a non-porous substrate in claim 1, third line, of U.S. patent 4,105,483 of record in this case (or in any of the other literally hundreds of thousands of patents issued with the term "substantially" in the claims) than the reflectivity here. The term "substantially" is commonly used in patent claims to prevent an infringer from avoiding literal infringement by minor changes, and is universally considered definite within the purview of 35 USC §112. See NRDC v Great Lakes Carbon, 188 USPQ 327, 333 (D. Del. 1975), wherein the court held:

"The term 'substantially' in this element of the claim is one commonly used in patents to prevent the avoidance of literal infringement by minor changes which do not themselves cause a loss of benefit of the invention. 1 A. W. Deller, Patent Claims §305 (2d ed. 1971). Indeed, there is authority for the proposition that its presence should always be implied in every claim, even when not introduced. Musher Foundation, Inc. v Alba Trading Co., Inc., 150 F.2d 885, 889, 66 USPQ 183, 186-187 (2d Cir. 1945)."

With respect to the limitation in claims 9 and 19 regarding the size of the logo, there is nothing indefinite about what is recited there. There is no requirement that something be defined in numerical terms. Definition in non-numerical terms, which is commonly referred to as "definition by result", is entirely acceptable. This is true not only with respect to the logo size limitation, but also with respect to the limitation regarding the material and its location and size to substantially eliminate the reflection of light into the human's eyes, for

example as recited in claim 17. In this regard attention is directed to In re Halleck, 164 USPQ 647, 649 (CCPA 1970):

"The claims were also rejected by the examiner as 'too broad and *** functional at the exact point of alleged novelty' because the claims failed to set out specifics regarding proportions of substances to be used. We have set out above our view that the 'exact point' of novelty lies in the discovery that the agents in question stimulate growth in animals, not in the amount used other than that it be an amount effective to stimulate growth. The functional term 'an effective amount *** for growth stimulation' is not objectionable where the amount as such is not critical and its use has been approved in many cases. See In re Caldwell, 50 CCPA 1464, 319 F.2d 254, 138 USPQ 243 (1963)." (Emphasis added)

In claim 9, line 6, the phrase ", with the letters or logo" was inadvertently left in in the previous amendment and this has been corrected by the amendment filed pursuant to MPEP 1207, submitted herewith.

The rejection of claims 9 and 10 saying that it is unclear whether the phrase "primarily black or dark colored" places any limitation with respect to the amount of area is not understood. As explained in the specification and illustrated in the drawings, the sports apparel or equipment manufacturer's or distributor's logo and/or letters are within a primarily black or dark colored area. For example see the "LOW" in figure 4. The terminology is completely understandable.

With respect to the objection to claim 10 asking how much is "most" of the light, it is not seen why the term "most" should be interpreted to have any different meaning than the normal use of that term. "Most" means the majority of (the first definition in Webster's New Collegiate Dictionary, page 751, 1973).

With respect to the objection to claim 17 reference is again made to the definition by result discussed above. The fact that the area may differ in size for different people does not make claim 17 indefinite. People of vastly different size would simply use differently sized decals or temporary tattoos, just as they use differently sized everything else. There is no relationship whatsoever between this limitation and the ability of someone to understand whether or not they were infringing the claims of a patent issued on this application.

In conclusion all of the claims are in clear conformance with 35 USC §112.

Claims 1, 2 and 8 Through 12 are Not Obvious Over the Conventional Use of Eye Black

In making this rejection -- despite the protestations to the contrary on page 5 of the Final Rejection -- the language "predefined clearly demarcated geometric shape" has been ignored, impermissibly, when evaluating the claims. The individual elements of this term should not be dissected out and individually given a different interpretation applying different arguments about the prior art with an attempt to show that the invention ensues. Rather the terminology must be considered as a whole.

Claims are to be given their broadest reasonable interpretation during prosecution, with emphasis on the term "reasonable". In re Royka 180 USPQ 580, 582, 583 (CCPA 1974). This reasonable interpretation must also be consistent with the specification. In re Saether, 181 USPQ 36, 39 (CCPA 1974). Here considering the limitations together it is clear that "predefined" cannot merely be

ignored but modifies all of the other language in the claim relating to the invention. As the previously submitted copy of a page from Webster's Third International Dictionary makes clear, something is "predefined" if it is defined or determined in advance. One applying conventional eye black does not define or determine a clearly demarcated geometric shape in advance. Rather one merely smears it on at the top of the cheek bone where the reflection is most likely to occur and accepts whatever form it is applied in. This is clear from the Sports Illustrated cover page. The terms "predefined clearly demarcated geometric shape which provides a non-verbal communication to others" is specifically described in the specification as clearly distinguishing from conventional eye black.

Also, in the Final Rejection the language of claim 1 is being misinterpreted by alleging that the conventional use of eye black provides a non-verbal communication that someone is a participant in an athletic event. Claim 1 does not call for the non-reflective material to provide a non-verbal communication to others, but rather its predefined clearly demarcated geometric shape to provide the communication. The shape of the eye black on the Sports Illustrated cover provides no non-verbal communication. The invention, on the other hand, as indicated by the illustrated embodiments, does communicate something to others, such as "I Support the Panthers Team", "I Wear 'HIGH' Shoes", etc.

The suggestion that the application of eye black in a particular predefined shape would be a matter of obvious design is mere speculation. Eye black has

been around for decades. Despite this fact, and despite the fact that advertising messages of virtually all types have been provided associated with athletic contests (billboards in stadiums, scoreboard messages, logos on TV screens during World Cup matches, identifying logos on shirts, shoes, and pants of athletic contests participants, etc.), no one heretofore has provided the invention. This is a clear indication of unobviousness and the mere incantation of the words "obvious design choice" cannot overcome these facts.

It is also noted that in the rejections of these claims numerous limitations of the claims have been ignored. For example why would one take off the specific design applied after an athletic event, as recited in claim 2, if the reasoning in the Final Rejection is followed? Also, there is absolutely no teaching whatsoever of the clearly demarcated predefined geometric shape being a sports apparel or equipment manufacturer distributor's logo as set forth in claims 8-10, or of the size of claim 9. Despite the fact that such logos have been put on virtually everything in the past they have not been positioned where eye black is conventionally positioned as according to the invention. Further there is absolutely no teaching of such a positioning of the particular (but distinct between the claims) predefined shapes set forth in claims 11 or 12, or the dull or matte color to have the wavelength set forth in claim 10. Therefore the dependent claims are even more clearly allowable.

All of claims 1, 2 and 8 through 12 are clearly allowable over conventional eye black, a substance that has been used for decades yet heretofore has never been used as recited in the claims at issue.

Claims 1, 2, 6 Through 13 and 16 Through 19 are Not Obvious Over Conventional Temporary Tattoos

It is clear from the comments on pages 7 and 8 of the Final Rejection that a major reason for the shotgun rejections of all of these claims is the failure to give weight to limitations in the claims. The failure to give weight to limitations regarding size, reflectivity, definition by result, etc. is completely impermissible as set forth in the discussion of the indefiniteness rejections. Despite the fact that there are literally dozens of pages in the Team Dynamics, J.B. Marketing, and Anderson's brochures that relate to temporary tattoos or decals, not one of them is illustrated and/or colored so that it will function in the manner clearly set forth in the claims at issue. If the invention were so obvious why did not Team Dynamics, Anderson's, and J.B. Marketing, in their dozens of pages of literature, illustrate the use as according to the present invention? Also despite the literally hundreds of different temporary tattoo designs illustrated in these documents if it were so obvious to provide the logo or name of a sports apparel or equipment manufacturer or distributor, why isn't one provided?

Also the comments on page 7 of the Final Rejection simply acknowledge applicants' arguments, and do not provide any reason why applicants' arguments are not persuasive. Rather with the benefit of hindsight the Final Rejection uses

the invention as a guide through the maze of the prior art to provide the invention. This is impermissible. As the Federal Circuit has repeatedly found, it is impermissible to use the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See Grain Processing Corp. v American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

In fact, there are at least two enormous differences between what is recited in claims 1 and 17 and the temporary tattoo/decal prior art applied. One is that the temporary tattoos/decals are typically not of the type of dull, matte, non-reflective material provided according to the invention. The second is that they are not dimensioned or positioned so as to cover the area of reflective light location on a wearer's cheek, that is on the upper cheekbone. It is clear that this has been recognized in the Final Rejection, but is explained away by -- with the benefit of applicants' invention in mind -- pointing out how one might modify the existing brochures and information, or by saying the limitations are "indefinite".

It should be emphasized that one cannot ignore the clear statement, both explicit and implicit, made in the references, that the temporary tattoos are not to be applied in the area of the eye merely because applicants have shown for their purposes they may be¹. Also the last sentence in the second full paragraph on

¹See the "Game Faces" brochure, last inside page, entitled "Holiday FacesTM": "Transfers should not be applied near the eyes or on sensitive skin."

page 7 of the first Action (incorporated in the Final Rejection) is erroneous. The Team Dynamics brochure and the J.B. Marketing brochure do not show temporary tattoos applied as close to the eyes as would be applied in the present invention. For example the cover sheet of the Team Dynamics brochure shows the tattoo applied at the area of the side of the cheekbone, the most prominent position of the face. That is where the skin bulges out and is most easily seen, and that is obviously the preferred location for placing a tattoo if the only purpose is to use it as a decoration. However where one has as another purpose for using it [i.e. to prevent reflectance of light into the eyes], then rather than placing the tattoo on the prominently extending cheek portion, one places it as set forth in the claims, namely underneath the eyes where it will prevent incident light from being reflected into the eyes. In none of the positions of the tattoos in the Team Dynamics brochure will the tattoo -- even if it were dull and matte rather than reflective (which it is) -- prevent incident light from being reflected into the eyes.

The same is true of the J.B. Marketing brochures. The only illustration the undersigned can find in the J.B. Marketing brochures for temporary tattoos applied to the face are those applied to little children's faces, and in those situations they are remote from the under eye area, taking seriously the explicit caution provided in the Team Dynamics materials that the tattoos or transfers should not be applied near the eyes. The Anderson illustrations are to the same effect. The illustrations in the Anderson reference show the "Cheek Cheers"

applied, as would be expected, at prominent locations at the sides of the cheeks, and not where recited in the instant application claims.

What is implicitly taught by all of the brochures that show the transfers and temporary tattoos? That one is not to place the temporary tattoos under the eyes in the position called for in the claims at issue. Not only is this implicitly taught it is explicitly stated in the Team Dynamics materials. Therefore the invention is clearly unobvious for this reason alone.

Also, an alleged conflict between what the references show and what is perceived to be the general "matte" appearance of tattoos cannot serve as the basis for the obviousness rejection. The claims at issue do not merely call for a matte appearance. Rather they call for -- in the case of both claims 1 and 17 -- a non-reflective colored and finished material. Therefore even if a real tattoo is considered to be "matte", that does not in any way, shape or form teach the claimed invention. Even if matte, real tattoos may have reflectively colored portions.

Further, it is clear from all of the advertisements submitted that in any situation where a decal or temporary tattoo is applied to the face it is illustrated as reflective and brightly colored. This is clear from an inspection not only of the Anderson's and Team Dynamics brochures which show all reflective (shiny) finish, brightly colored decals, but also the J.B. Marketing brochures which, even though they show in other locations decals that are matte (for example on the arm of the

male model in the J.B. Marketing brochure that says "Value Pack Program" at the top and has a picture of a man and woman each with arm tattoos covering up the vast majority of the cover), that is not true for the face tattoos. Applicants' understanding is that there is a clear reason for this. Marketers of these temporary tattoos and decals do not want them to look like real tattoos when applied to the face. The reason for that is that real tattoos on a face would, certainly in at least American society, be associated with low class and/or motorcycle gang individuals. The manufacturers would not want their products restricted to such groups or identified with such groups, and therefore they make their decals brightly colored with highly reflective finishes. This is completely clear from the numerous decals and photographs, all associated with facial application of decals, in the Team Dynamics brochure.

Further, with respect to claims 17 through 19, it is not the "intended use" of the decals/temporary tattoos recited therein which distinguish them from the prior art. It is the specific limitations. In particular the limitations of being non-reflective colored and finished material of sufficient size and reflectivity to substantially eliminate the reflection of incident light, and dimensioned to substantially cover the area of a reflective location on the cheek at which incident light would be reflected into a human's eyes. These are specific limitations, not a statement of intended use, and are not taught by the applied references.

Also the fact that the shape (although not necessarily size) of the temporary tattoo illustrated in figure 6 of applicants' drawings was taken from the Team Dynamics brochure is not in any way, shape or form an indication of unobviousness because the invention recited in many of the claims does not distinguish from the conventional decals in shape, but rather in reflectivity, size, and/or position (usé). As a matter of fact this illustrates the unobviousness of the invention! The panther illustrated in the Team Dynamics brochure has undoubtedly been a popular shape for many years, and in fact is only one of a handful of decals in the entire Team Dynamics brochure that is so popular that it is offered in four or more colors. Yet despite this no one heretofore thought to make it non-reflective and dimension it and position it so that it could be used like conventional eye black! This indicates unobviousness not obviousness.

It would appear that the invention is being rejected here because it is simple. However its simplicity is an indication of its unobviousness, not obviousness. In this regard see In re Sporck, 133 USPQ 360, 363, wherein the CCPA held:

"Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is often times the very thing that is not obvious before they are made. This court, in In re Osplack, 39 CCPA 932, 195 F.2d 921, 93 USPQ 306, 308, stated:

We think this case is one of that category of inventions which, when viewed after disclosure and explanation by an applicant, seem simple and such as should have been obvious to those in the field. Yet this does not necessarily negative invention or patentability. Goodyear Tire & Rubber Co., Inc. et al v Ray-O-Vac Company, 321 U.S. 275, 60 USPQ 386; In re DeLancey, 34 CCPA 849, 159 F.2d 737, 72 USPQ 477. Indeed, simplicity may even be some evidence of invention. Baldwin-Southwark Corporation v Tinius Olsen Testing Mach. Co. et al, 88 F.2d 910, 32 USPQ 366.

The fact that the invention seems simple after it is made is not determinative of the question of obviousness. If this were the rule, many of the most beneficial patents would be stricken down. *If those skilled in the mechanical art, are working in a given field and have failed to discover a certain new and useful improvement, the one who first makes the discovery frequently has done more than make an obvious improvement which would have suggested itself to a mechanic skilled in the art, and such an invention is entitled to the grant of a patent thereon.* Expanded Metal Co. v Bradford, 214 U.S. 366." (Emphasis added.)

All of the claims are clearly unobvious over the conventional temporary tattoos and decal brochures.

Further there are numerous limitations of the dependent claims that are not even remotely suggested by the references, nor are they even discussed in the Final Rejection. For example there is no teaching whatsoever of the particular shapes of claims 8 through 13, 18, or 19 (incorporated by reference herein). The provision of such shapes have numerous advantages compared to the prior art. For example the sports equipment manufacturers or distributors logos are a highly

appealing way of directly advertising one's product, although subtle. For example, again visualize the situation where at the Super Bowl the starting teams are being introduced and, as always happens, the camera focuses in on each of the player's faces. Suppose that several of the players have their eye black in the predefined shape of the "Low" shoe manufacturer logo. What is that exposure worth to the manufacturer? Shoe manufacturers conventionally pay millions of dollars a year to athletes just to wear their shoes, which are much less visible to TV spectators than would be the eye black on a player's face during player introductions. The invention is the epitome of an unobvious invention.

Further, claim 2 clearly distinguishes from the art since none of the brochures suggest participants in athletic contests using the temporary tattoos/decals by placing them on within a few hours before the start of an athletic contest and then removing them a few hours or less afterwards. While the method set forth in claim 6 is in general the conventional manner of applying temporary tattoos, there is no suggestion whatsoever of applying the temporary tattoo in the manner set forth therein where necessary according to the invention in order to accomplish the results set forth in claim 1. With respect to claim 11 while the Game Faces brochure, as well as others, does show sports team names, mascots, or logos, again in view of the longstanding knowledge of those designs, as well as the statement on the last page (back cover) of the Team Dynamics brochure that "We also stock more than 75 major college designs. College

cheerleaders and fans² are often shown wearing Team Dynamics' Game Faces® during televised games" no one has heretofore thought of the participants using them, as set forth in claim 11 (which depends from claim 2), and also to function to prevent reflection into the participant's eyes. Nor is there even the most remote suggestion of providing the colors set forth in claim 10, or the directional bias set forth in claim 13.

In conclusion, all of the claims clearly patentably distinguish from the conventional decal/temporary tattoo art.

VII. CONCLUSION

All of the claims are in proper form and clearly patentably distinguish from the art therefore early reversal of the Final Rejection, and passage of all of the claims (including the non-elected claims since they depend from allowed claims) to issue are earnestly solicited.

²Emphasis added. Also no sports participants are shown in any of the brochures wearing the decals/temporary tattoos.

COMISKEY et al
Serial No. 08/240,895

- 22 -

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Robert A. Vanderhye
Reg. No. 27,076

RAV:eaw
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4004
Facsimile: (703) 816-4100

COMISKEY et al.
Serial No. 08/240,895



- 23 -

VIII. APPENDIX -- CLAIMS ON APPEAL

1. A method of reducing reflected light glare into a human's eyes from the human's cheeks while simultaneously providing a non-verbal communication to others, comprising the steps of:

(a) applying underneath the human's eyes, on the human's cheeks, covering a reflective location on the cheeks at which incident direct or indirect light is likely to be reflected into the human's eyes, a non-toxic material having a non-reflective colored and finished exterior in the form of a predefined clearly demarcated geometric shape which provides a non-verbal communication to others; and

(b) within a week after application of the non-toxic material having a non-reflective colored and finished exterior from step (a), removing it.

2. A method as recited in claim 1 wherein the human is a participant in an athletic contest, and wherein step (a) is practiced within a few hours or less before the start of the athletic contest and so that the material substantially eliminates reflection of incident direct or indirect light off the participant's checks into the participant's eyes, and step (b) is practiced within a few hours or less after the athletic contest is over.

6. A method as recited in claim 2 wherein the material is a temporary tattoo, provided on a substrate, the temporary tattoo provided on a top face of the substrate and illustrating the reverse of the clearly demarcated geometric and

predefined shape, and the substrate having a bottom face; and wherein step (a) is practiced by cleaning a cheek where the temporary tattoo is to be applied, putting the temporary tattoo on the top face of the substrate on the reflective location of the human's cheek to which it is to be applied, wetting the bottom face of the substrate with water and pressing it into contact with the cheek for sufficient time for the temporary tattoo to adhere to the cheek, and sliding off the substrate from the temporary tattoo.

7. A method as recited in claim 6 wherein step (b) is practiced by rubbing the temporary tattoo off using alcohol or baby oil, or applying tape thereto and then pulling off the tape.

8. A method as recited in claim 2 wherein step (a) is practiced to provide as the clearly demarcated predefined geometric shape a sports apparel or equipment manufacturer's or distributor's logo, the logo having a size complying with regulations of any regulatory body which oversees the athletic contest.

9. A method as recited in claim 2 wherein step (a) is practiced to provide as the clearly demarcated predefined geometric shape a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor within a primarily black or dark colored area, and sized to comply with regulations of any regulatory body which oversees the athletic contest, with the letters or logo, or any demarcation between any letters or logo and the primarily

black or dark colored area, appearing as a dull or matte color and absorbing most of the light in the visible spectrum.

10. A method as recited in claim 9 wherein step (a) is further practiced by providing the letters, or any demarcation between any letters and the primarily black or dark colored area, appearing as a dull or matte color having a wavelength of greater than about 690 nm and less than about 430 nm, and absorbing most of the light in the visible spectrum.

11. A method as recited in claim 2 wherein step (a) is practiced to provide as the clearly demarcated geometric and predefined shape a representation of a sports team name, mascot or logo.

12. A method as recited in claim 1 wherein step (a) is practiced to provide as the clearly demarcated geometric and predefined shape a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor.

13. A method as recited in claim 12 wherein step (a) is further practiced to apply a logo having a directional bias, and by applying the logo with the correct directional bias under one of the human's eyes, and with the reverse of the correct directional bias under the other of the human's eyes.

16. A method as recited in claim 12 wherein the material is a temporary tattoo, provided on a backing, the temporary tattoo provided on a top face of the backing and illustrating the reverse of the clearly demarcated geometric and

predefined shape, and the substrate having a bottom face; and wherein step (a) is practiced by cleaning a cheek where the temporary tattoo is to be applied, putting the temporary tattoo on the top face of the backing on the reflective location of the human's cheek to which it is to be applied, wetting the bottom face of the backing with water and pressing it into contact with the cheek for sufficient time for the temporary tattoo to adhere to the cheek, and sliding off the backing from the temporary tattoo.

17. A decal or temporary tattoo having a clearly demarcated geometric and predefined shape and dimensioned to substantially cover the area of a reflective location on the cheek at which incident direct or indirect light is likely to be reflected into the human's eye, said temporary tattoo or decal being non-toxic and having an exterior, when applied, surface of non-reflective colored and finished material of sufficient size and non-reflectivity to substantially eliminate the reflection of incident direct or indirect light off the human's cheek into the human's eye.

18. A decal or temporary tattoo as recited in claim 17 wherein the clearly demarcated geometric and predefined shape is a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor, no part of the shape that is not a dull or matte black or dark color having a size significant enough to allow significant reflection of incident direct or indirect light off the human's cheeks into the human's eyes.

19. A decal or temporary tattoo as recited in claim 17 wherein the clearly demarcated geometric and predefined shape consists of a sports apparel or equipment manufacturer's or distributor's logo, and wherein the clearly demarcated geometric and predefined shape has a size complying with regulations of any regulatory body which oversees the participants in an athletic contest by whom the decal or temporary tattoo is utilized.